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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,759	06/18/2001	Dan S. Bloomberg	D/89194CCR	2840

7590 10/07/2003

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Xerox Square
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Rochester, NY 14644

EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/884,759	BLOOMBERG ET AL.	
	Examiner	Art Unit	
	Jared J. Fureman	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-15, 18-22 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

It is acknowledged that this application is a reissue of U.S. Patent application serial number 08/240,798, which issued as U.S. Patent number 6,076,738. The parent application, including art cited, has been reviewed.

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. In this case, there is no reference to application number 08/240,798.

Specification

2. The abstract of the disclosure is objected to because the abstract is greater than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 12 is objected to because of the following informalities: Claim 12, line 1: the extra period after "12" should be deleted. Appropriate correction is required.

Reissue Applications

4. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. Claims 9-15, 18-22, and 25-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In this case, claims 9-15, 18-22, and 25-28 do not contain the limitations that the glyph shapes are "rotationally variant" or "rotationally invariant" (as recited in claims 1 and 4 of the 6,076,738 patent). During prosecution of the parent application (U.S. Patent application serial number 08/240,798, which issued as U.S. Patent number 6,076,738), applicant's argued that the limitations "rotationally variant" and "rotationally invariant" defined the claims over the prior art of record (see pages 6, 12, and 13 of the appeal brief received on 8/5/1996 (paper number 31), of the 08/240,798 application; page 2 of the request for reconsideration received on 8/6/1993 (paper number 14), of the 08/240,798 application; and pages 11 and 12 of the amendment received on 12/16/1991 (paper number 7), of the 08/240,798 application). Thus, applicants have surrendered any subject matter not including the limitations that the glyph shapes are "rotationally variant" or "rotationally invariant".

Allowable Subject Matter

7. Claims 1-8 have been allowed over the prior art of record.
8. Claims 16, 17, 23, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for allowance and for the indication of allowable subject matter: While various prior art of record individually teaches some of the features of the claimed invention (for example: Uno et al (US 4,286,146) teaches storing values on a hardcopy recording medium by encoding the values in corresponding glyph shapes (see figure 16); Vinal (US 3,798,319), Mansour (IBM

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Technical Disclosure Bulletin, vol. 26, no. 2, pages 766-767, July 1983), and Bossen et al (US 6,179,207) all teach self-clocking codes), without the benefit of applicant's teachings, there is no motivation for one of ordinary skill in the art at the time of the invention to combine the various features taught by the prior art in a manner so as to create the claimed invention.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bossen et al (US 6,179,207 B1), Bloomberg et al (US 5,091,966), Stearns et al (US 5,128,525), Bloomberg (US 5,168,147), Hecht (US 5,221,833), Tow (US 5,315,098), Bloomberg et al (US 5,091,966), Van Tyne et al (US 5,073,954), Kawamoto et al (US 4,980,823), Sant'Anselmo et al (US 4,924,078), Nishihara (US 4,905,296), Stentiford (US 4,817,171), Brass et al (US 4,754,127), Brass et al (US 4,728,783), Hongo (US 4,630,308), Blum et al (US 4,610,025), Uno et al (US 4,286,146), Morton (US 4,115,806), Vinal (US 3,978,319), Bigelow et al (US 3,898,434), Vaccaro (US 3,654,435), Van Berkel et al (US 3,257,545), Blum et al (WO 86/00445 A1), Pastor (GB 2 179 008 A), Suzuki et al (JP 62-140554 A), and Mansour (IBM Technical Disclosure Bulletin, vol. 26, no. 2, pages 766-767, July 1983) all teach machine readable codes stored on hardcopy recording medium and/or code readers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

September 11, 2003

Jared J. Fureman
Jared J. Fureman
Art Unit 2876